PATENT 600-1-087 CIP1CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Jeffrey M. Friedman et al.		
SERIAL NO.:	09/635,864	EXAMINER :	Christine J. Saoud
FILED:	August 10, 2000	ART UNIT :	1647
FOR:	OB POLYPEPTIDES, MODIFIED FORMS AND COMPOSITIONS		

(As Amended)

#10
M.P.J
4/2/03

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(Name of Registered Rep.)

3/10/03
(Signature and Date)

RESPONSE TO COMMUNICATION FROM EXAMINER DATED OCTOBER 10, 2002

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This paper is filed in response to the Office Action (paper 8) dated October 10, 2002, in which the Examiner indicated that the response to restriction requirement dated November 28, 2001 requires an election of invention of nucleic acid for Group I, which was previously elected, even though the requirement was traversed. In response, Applicants elect ***with traverse***, the sequence of SEQ ID NO:3.

As a preliminary point of clarification, Applicants provide the following information regarding the sequences discussed in the claims of Group I:

SEQ ID NO:1	nucleic acid sequence of murine *OB* cDNA;
SEQ ID NO:2	deduced amino acid sequence of murine OB polypeptide;
SEQ ID NO:3	nucleic acid sequence human *OB* cDNA;

SEQ ID NO:4	deduced amino acid sequence of human *OB* polypeptide;
SEQ ID NO:5	full length amino acid sequence of murine *OB* sequence lacking glutamine at position 49.
SEQ ID NO:6	full length amino acid sequence of human *OB* sequence lacking glutamine at position 49.
SEQ ID NO:22	genomic sequence of human *OB* gene.

Applicants submit that the Examiner has not shown that a serious burden would be required to examine all of the claims. M.P.E.P. § 803 provides:

> If the search and examination of an application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, for a restriction to be proper, the Examiner must satisfy the following two criteria: (1) that independent and distinct inventions are being claimed (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. See M.P.E.P. § 803.

Firstly, Applicants respectfully disagree with the Examiner's assertion that the different nucleic acid are independent and distinct "because no common structural or functional properties are shared." The nucleic acids in question encode OB polypeptides, *e.g.*, cDNA sequence of SEQ ID NO:3 which encodes human OB polypeptide of SEQ ID NO:4; cDNA sequence of SEQ ID NO:1, which encodes murine OB polypeptide of SEQ ID NO:2 or genomic sequence of human OB (SEQ ID NO:22). The polypeptides encoded by these sequences all have a common function in that they are all body weight modulating polypeptides. Hence, contrary to the Examiner's assertion, the nucleic acids that encode the OB polypeptides have a common function and hence the restriction requirement for election of one of the sequences is improper.

Secondly, Applicants respectfully submit that the Examiner has not shown that it would be a serious burden to search and examine the nucleic acids in one group. The mere fact that there are multiple inventions in an application does not automatically merit a

restriction requirement. As discussed above, the nucleic acids in question all have a common function in that they encode OB polypeptides that modulate body weight. A search relating to compositions which encode a human OB polypeptide (*e.g.*, a nucleic acid of SEQ ID NO:3 which encodes a polypeptide of SEQ ID NO:4) would significantly overlap with the search required for compositions relating to a nucleic acid that encodes a murine OB polypeptide (*e.g.*, a nucleic acid of SEQ ID NO:1, which encodes a polypeptide of SEQ ID NO:2). The Examiner has not shown that an undue burden would be produced by the combined search. Indeed, as indicated in the previous response, claims 59-70 of the instant application are directed to nucleic acids which correspond to the polypeptide claims allowed in U.S. Serial No. 08/438,431, further supporting the Applicants' position that it would not constitute an undue burden to examine the claims in one group. Accordingly, Applicant submits that restriction between the nucleotide sequences of SEQ ID NO:1, SEQ ID NO:3 and SEQ ID NO:22 encoding SEQ ID NO:2, SEQ ID NO:4, or variant mouse or human polypeptide such as *e.g.*, SEQ ID NO:5 and SEQ ID NO:6 is improper.

Applicants respectfully request entry of the foregoing remarks in the file history of the instant application. The claims in the present case are believed to be in condition for allowance, and early indication of such a favorable disposition is respectfully requested. Should the Examiner wish to discuss the case further, she is invited to call the undersigned at the number listed below.

Respectfully submitted,

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